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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,087	11/09/2001	Mark C. Sapienza	010371-9025-00	2568

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 01/08/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,087

Applicant(s)

SAPIENZA ET AL.

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 21-28 is/are allowed.
- 6) ☒ Claim(s) 12 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10, 11 & 13. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kline ('435) in view of Pitts ('349).

Kline discloses a three ring binder (60) comprising a first cover and a second cover and having a plurality of divider sheets (26, 28, 30, 32, 34) having tabs (36, 38, 40, 42, 44) and holes (66, 68) coupled with the cover of the three ring binder and sheets (22), wherein the tabs extend beyond the sheets (as seen in figure 4).

Kline discloses the claimed invention except for explicitly disclosing a substantial portion of the second cover being opaque. It would have been obvious to one having ordinary skill in the art at the time the invention was made to any desired material (i.e., opaque, transparent, translucent, plastics, etc.) for the second cover absent a showing of criticality, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Furthermore, as seen in figure 4, Kline discloses the covers being made of a material that is not transparent.

Kline discloses the claimed invention except for the binder being made of a transparent material enabling viewing of the tabs when the first and second covers are in a closed position.

Pitts discloses a flexible transparent notebook for holding a stack of sheets comprising a first cover (38), a second cover (39) and a three-ring binder mechanism (50). The transparent thermoplastic material enables viewing of items retained within the notebook. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kline's invention to include transparent first and second covers, as taught by Pitts, to allow easy viewing of the contents within the binder without opening the binder.

Regarding claim 18, it would have been an obvious matter of design choice to provide any desired dimensions for the covers, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 19, the sheet holder is a ring binder as defined above.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kline in view of Pitts and further in view of Fournier ('905).

Kline, as modified by Pitts, discloses the claimed invention except for the sheet holder being a spiral-bound notebook.

Fournier discloses a coil-bound notebook. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kline's invention to provide the sheet holder being a spiral-bound notebook, as taught by Fournier, as an alternative, conventional device for holding the stack of sheets.

Allowable Subject Matter

4. Claims 1-11 and 21-28 are allowed.
5. Claims 13-17 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed October 16, 2003 have been fully considered but they are not persuasive.

Applicant argues that Kline, as modified by Pitts, fails to disclose a substantial portion of the second cover being opaque as recited in newly submitted claim 12. The examiner maintains that it would have been obvious to provide any desired material for producing the covers of the sheet holder, to include a partially transparent or translucent material or completely transparent material. Therefore, the examiner maintains that the material selected by the user determines the appearance of the covers of the sheet holder.

It is noted that Fournier is used solely for disclosing a conventional spiral-bound sheet holder and has not been relied upon for disclosing any of the other claimed limitations.

Note: The remarks with respect to claims 13-17 are moot.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-

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0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

January 7, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER